

REMARKS/ARGUMENTS

This Amendment is submitted in response to the Office Action mailed April 20, 2009. Claims 1-12, 20-29, 30-38 and 41-49 are rejected. In this Amendment, claims 1, 20, 30, and 41 have been amended. Claims 50 and 51 have been added. No claims have been cancelled. It is respectfully submitted that the amendment does not add new matter. Applicants reserve all rights with respect to the applicability of the Doctrine of Equivalents. Applicants respectfully request consideration of the subject application as amended herein.

Claim Rejections Under 35 U.S.C. § 101

The Examiner rejects claims 1-12, 20-29, 30-38 and 41-49 under 35 U.S.C. § 101 as not falling within one of the four statutory categories. Applicants respectfully disagree. Applicants have amended the claims, and submit that claims 1, 20, 30, and 41, and the claims that depend therefrom, are directed to statutory subject matter. Therefore, Applicants respectfully request withdrawal of the rejections under § 101.

Claim Rejections Under 35 U.S.C. § 102

The Examiner rejects claims 1-12, 20-29, 30-38 and 41-49 under 35 U.S.C. § 102(a) as being anticipated by Fitzpatrick, et al. (U.S. Patent No. 7,266,583, hereinafter "Fitzpatrick"). Applicants respectfully disagree.

Fitzpatrick describes a system that provides contact management for a chat system (Fitzpatrick, column 4, lines 45-56). During a chat session, facilitated by a chat server, a first user may access the contacts of other users (Fitzpatrick, column 4, lines 45-65; column 7, lines 29-52). Furthermore, the first user may be able to modify the contacts of other users (Fitzpatrick, column 7, lines 53-64). As described in Fitzpatrick,

chat users can set permissions that indicate whether their contact lists can be accessed and/or modified (Fitzpatrick, column 8, lines 11-39). Furthermore, the server computer enables the access to contact lists and the ability to modify the contact lists of others (Fitzpatrick, column 9, lines 54-59; Figure 1).

Amended claim 1 recites:

An instant messaging (IM) system comprising:
an IM server connected to a communication network; and
a processor of the IM server to execute logic operable on the IM server enabling a first user to browse contacts associated with a second user, wherein the logic enables the second user to act as an intermediary client between the first user and a third user in response to a request by the first user to add the third user, which is a contact associated with the second user, as a contact of the first user.

In accordance with the language of claim 1, an instant messaging system includes an IM server. Logic operable on the IM server enables a first user to browse contacts associated with a second user. The logic enables the second user to act as an intermediary client between the first user and a third user, which is a contact of the second user, in response to the first user attempting to add the third user as a contact. Applicants respectfully submit that Fitzpatrick fails to describe each and every feature, as claim.

As discussed above, Fitzpatrick describes that a user may edit the contact list of other users. Furthermore, the user may also directly access the contact list of other users. Then, when the user has accessed a specific contact list, the user may add contacts from that list without notification of the addition being sent to the user's new contact (Fitzpatrick, column 8, lines 11-19 and column 8, lines 48-55). The only constraint placed upon a user adding a third party contact to his contact list, is an accessibility status

which would prevent the user from viewing the contact list in the first place (Fitzpatrick, column 8 line 62 to column 9, line 20).

Applicants, however, claim in part "the logic enables the second user to act as an intermediary client between the first user and a third user in response to a request by the first user to add the third user, which is a contact associated with the second user, as a contact of the first user." In accordance with the language recited in claim 1, the second user acts as an intermediary between the first and third user to facilitate the first user adding the third user as a contact. Fitzpatrick does not require a user to stand between and mediate the first user adding the third user to the first user's contact list, as claimed. In contrast, Fitzpatrick states:

When chat session participant 300 compares the associated contact list 310 to contact list 110 and 210, ABC Memory and EFG Harddisks records can be highlighted since they are not contained in contact list 310. Chat session participant 300 can subsequently add ABC Memory and EFG Harddisks to contact list 310. The comparison will also show that Deloris Disks and Parkway Drives records are not on contact lists 110 and 210. Since contact list 110 is modifiable by chat session participant 300, chat session participant 300 can add the Deloris Disks and Parkway Drives records to contact list 110. Chat session participant 300 must request permission from chat session participant 200 in order to modify contact list 210 since the icon indicates and "A" and not "M." If chat session participant 300 is given permission to modify contact list 210 and the modification is made, chat session participant 200 can have the option of accepting or rejecting the modification. If the modification is rejected by chat session participant 200, then the modification made by chat session participant 300 will have no effect on contact list 210. If the modification made by chat session participant 300 is accepted by chat session participant 200, then the addition of the Deloris Disks and Parkway Drives records to contact list 210 will become permanent. On further comparison, chat session participant 300 will recognize that NOP Megabytes from contact list 210 and HIJ Memory from contact list 110 is not in contact list 310. Chat session participant 300 can subsequently add HIJ Memory and NOP Megabytes to contact list 310.

(Fitzpatrick, column 8, lines 11-40 [Emphasis Added])

Thus, user 300 of Fitzpatrick need only access the contact list of users 200 and 300 in order to add new contacts to user 300's contact list. Users 200 and 300, however, are not described as being an intermediary between user 300 and the users associated with the contacts user 300 intends to add to his contact list.

The Examiner states "Fitzpatrick teaches that anyone of the participants can be permitted modify a contact list of the other participant, thereby allowing to participant to acts as an intermediary in response to the request of the participant who is modifying the list (0030-0031)" (Office Action, mailed 4/20/09, page 10). Applicants are unclear as to the specific passage(s) the Examiner is relying on, however, Fitzpatrick does discuss contact list modification at column 7, lines 53-56 and column 8, lines 19-35. In those passages Fitzpatrick notes that users, on their own initiative, may modify the contacts of other users (Fitzpatrick, column 7, lines 53-56), and that if a user's permission status does not allow modifications, the user's permission must first be obtained before contacts are modified (Fitzpatrick, column 8, lines 19-35). Although Fitzpatrick describes the ability of a user to directly, and at his own initiative, modify the contacts of another, Fitzpatrick fails to describe a user acting as an intermediary to facilitate other users adding contacts. Thus, Fitzpatrick fails to describe "the logic enables the second user to act as an intermediary client between the first user and a third user in response to a request by the first user to add the third user, which is a contact associated with the second user, as a contact of the first user," as claimed.

Therefore, Applicants respectfully submit that Fitzpatrick fails to describe each and every feature claimed in independent claim 1, and thus fails to anticipate claim 1. Furthermore, claims 2-12 depend from claim 1, and include additional limitations and features, and thus are also not anticipated by Fitzpatrick.

Independent claims 20, 30, and 41 include similar limitations and features as those discussed above with respect to independent claim 1. Thus, for at least the reasons discussed above, independent claim 20, 30, and 41 are also not anticipated by Fitzpatrick. Furthermore, claims 21-29, 31-38, and 42-49 depend from one of claim 20, 30, and 31, and include additional limitations and features, and thus are also not anticipated by Fitzpatrick.

Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-12, 20-29, 30-38 and 41-49 under 35 U.S.C. § 102(a) as being anticipated by Fitzpatrick.

New claims 50 and 51 have been added without introducing any new matter. New claims 50 and 51 depend from independent claim 1, and include additional limitations and features. Thus, for at least the reasons discussed above, with respect to independent claim 1, claims 50 and 51 are not anticipated by Fitzpatrick.

Furthermore, claim 50 requires that "the second user acts as an intermediary client through a client associated with the second user." Fitzpatrick describes that chat users can set permissions that indicate whether their contact lists can be accessed and/or modified by other users. Then, the other users directly access the contact lists in order to edit the contact lists (Fitzpatrick, column 8, lines 11-39). Fitzpatrick, however, does not require a user, let alone a "client associated with the second user," to stand between and mediate changes to a contact list. In view of this, Applicants respectfully submit that the present invention as claimed in claims 50 and 51 is not anticipated by Fitzpatrick.


Conclusion

Applicants respectfully submit that in view of the amendments and discussion set forth herein, the applicable rejections have been overcome. Accordingly, the present and amended claims should be found to be in condition for allowance. If a telephone interview would expedite the prosecution of this application, the Examiner is invited to contact the undersigned at (408) 720-8300.

If there are any additional charges/credits, please charge/credit our deposit account no. 02-2666.

Respectfully submitted,
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Dated: August 3, 2009



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